

REMARKS

Claims 1-16 are currently pending in the application. Claim 1 is the only claim in independent form.

The Office Action requested a copy of corrected drawings. Applicant submits herewith proposed corrected drawings showing corrections to the drawings in red. Upon allowance of the application, Applicant will provide formal drawings.

Independent claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,643,286 to Warner, et al. in view of U.S. Patent No. 6,413,263 to Lobdill, et al. It is undisputed that the Warner, et al. patent discloses a stereotactic probe holder. The Office Action states that the Warner, et al. patent teaches first and second guide elements 16, 12. However, the Warner, et al. patent teaches a single base member 12 including an adapter base portion 14 and base stop portion 16. As stated on the bottom of column 3 through the top line of column 4 of the Warner, et al. patent, the two portions of the base member are integral therewith, thereby forming a single guide member. It is also undisputed that the Warner, et al. patent discloses a first clamp 38 as part of the base member or guide member 16 in the form of a set screw and a second clamp or set screw 42, both clamps having a clamping position on the axis of assertion. Correctly, the Office Action states that the Warner, et al. patent does not teach one of the clamps being carried by a leg extending from a second guide and neither of the clamps being between the guide elements and the target. Hence, it is undisputed that the Warner, et al. patent does not disclose a clamp on each side of a pair of guides and Applicant notes that the Warner, et al. patent teaches a single guide, not a pair of spaced guides.

It is undisputed that the Lobdill, et al. patent discloses a stereotactic probe holder including a clamp 18 carried by a leg 32 in combination with legs 12 and 24, which extend from a microdrive 46 and clamps a probe between the microdrive and a target 48. The Office Action holds that it would have been obvious to one of ordinary skill in the art to modify the device of Warner, et al. with a clamp carried by a leg extending from a second guide and clamps between guide elements and the target as taught by Lobdill, et al. in order to grip the instrument near the target. It respectfully

submitted that upon closer inspection of the prior art, the prior art does not disclose all of the elements of amended independent claim 1, nor does either prior art reference suggest the combination of the two prior art references in order to derive the present invention. Moreover, it is respectfully submitted that the prior art teaches away from the combination of elements of the present invention.

More specifically, amended independent claim 1 claims a stereoguide including first and second guide elements spaced relative to each other and first and second clamps, the first clamp having a clamping position on the axis between the guide elements and the target and a second clamp having a clamping position on the axis of insertion and on the opposite side of the guide elements of the first clamp. This combination of clamps and guides allows for performance of the specific methods, as described in detail beginning on page 11, line 15, et seq. As specifically stated therein, the specific combination of guides and clamps and their positioning provide the particular advantage that, on the first pass, the guide wire being stiffened by the tube 20 hits the target and then by inserting a guide tube short of the target, the brain target is fixed and the guide tube facilitates the insertion of a very fine instrument to the target. The combination of insertion of the various tubes and elements, and the stiffening of the guide wire by the positioning of the specific positioning of the clamps, cannot at all be obtained by the prior art. Likewise, the device in independent claim 1 does not have to be assembled and disassembled to perform the disclosed method.

In contradistinction, the Warner, et al. patent provides, arguably, two clamps on the distal side of a single guide. It is undisputed that there is no clamp between the guide and the target, thereby allowing for drifting and lack of rigidity of the otherwise flexible probe element (wire). The Warner, et al. patent does not suggest the use of or at all disclose any need for a second clamp below the guide 12 (14, 16 in combination). As an alternative, the Warner, et al. patent discloses, in column 3, lines 23-39, the use of interchangeable instrument holding members as a means to adjust the disclosed device for various surgical instruments. It may require further design to facilitate attachment or an adapter sleeve must be attached to allow for attachment of various devices, but no suggestion at all is given with regard to means for further

rigidifying the probe extending from the guide, nor any means for preventing drift of the probe extending from the guide.

The Lobdill, et al. patent specifically discloses a single microdrive unit 46 and a single swiveling clamping member 18. It is black letter law that there must be some suggestion in the prior art for their combination to derive a claimed invention. The Lobdill, et al. patent, in a contrary manner, teaches away from any suggestion (keeping in mind that the suggestion should be in the primary reference, the Wagner, et al patent, which undisputedly is not found therein). The Lobdill, et al. patent specifically states, in column 2, lines 39 et seq., that "attempting to hold the probe at a point at or above the arch of the stereotactic frame allows for movement of the probe within the brain of the patient. In addition, the stereotactic apparatus is typically partially disassembled to expedite the anchoring procedure. Such disassembly can introduce mechanical displacement, disturbing the probe and moving it from its desired location. Incorrect placement of a probe reduces the degree of, or entirely prevents, the success of the surgical procedure. Accordingly, there is a need in the art for devices and methods that maintain the correct position of the probe during anchoring of the probe in the patient and during partial disassembly of the stereotactic apparatus." In other words, if one was to follow the teaching of the Lobdill, et al. patent, one would not use any clamping above the probes and would only use a clamp between the guide or microdrive and the target. The Lobdill, et al. patent requires this to allow for disassembly of the stereotactic apparatus for insertion of the probe. In contradistinction, the present invention does not require any disassembly of the stereotactic apparatus to allow for the probe insertions, as detailed and on page 11, lines 15, et seq., and as discussed above. Hence, even if one were to combine the teachings of the Warner, et al. and Lobdill, et al. patents as required by the disclosures in each patent, one would either have two clamps placed above the guide member, and not between the guide member and the target, as required by the Warner, et al. patent, or one would derive stereotactic apparatus including a single clamp between a microdrive and the target as required by the Lobdill, et al. patent and (1) abandon any further clamping and (2) have an assembly that requires disassembly for the insertion of the probe. In other words, taking the teachings of the prior art as specifically stated

therein, even a combination of the prior art references cannot be used to derive the present invention. It is further black letter law that one cannot ignore the teaching of the prior art references in order to combine them to derive an invention. This can only be done through hindsight after first understanding the present invention while ignoring specific requirements of the prior art. Hence, it is respectfully submitted that the presently pending independent claim is patentable over the cited prior art.

The remaining dependent claims are all ultimately dependent upon the independent claim discussed above. No prior art reference makes up for the deficiencies of that reference as no prior art reference teaches the claim combination of features that derive a novel result of the present invention. Such a combination, as discussed above, cannot derive the present invention without hindsight after first understanding the present invention and then applying it to the prior art.

It is noted that Applicant has further added claim 16. Claim 16 is a combination of limitations of previously allowed claim 11 with claim 7, which is ultimately dependent upon claim 1. Hence, it is respectfully submitted that new independent claim 16 is allowable subject matter.

In view of the above, it is respectfully submitted that the application is now in condition for allowance, which allowance is respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



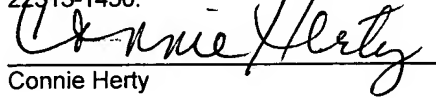
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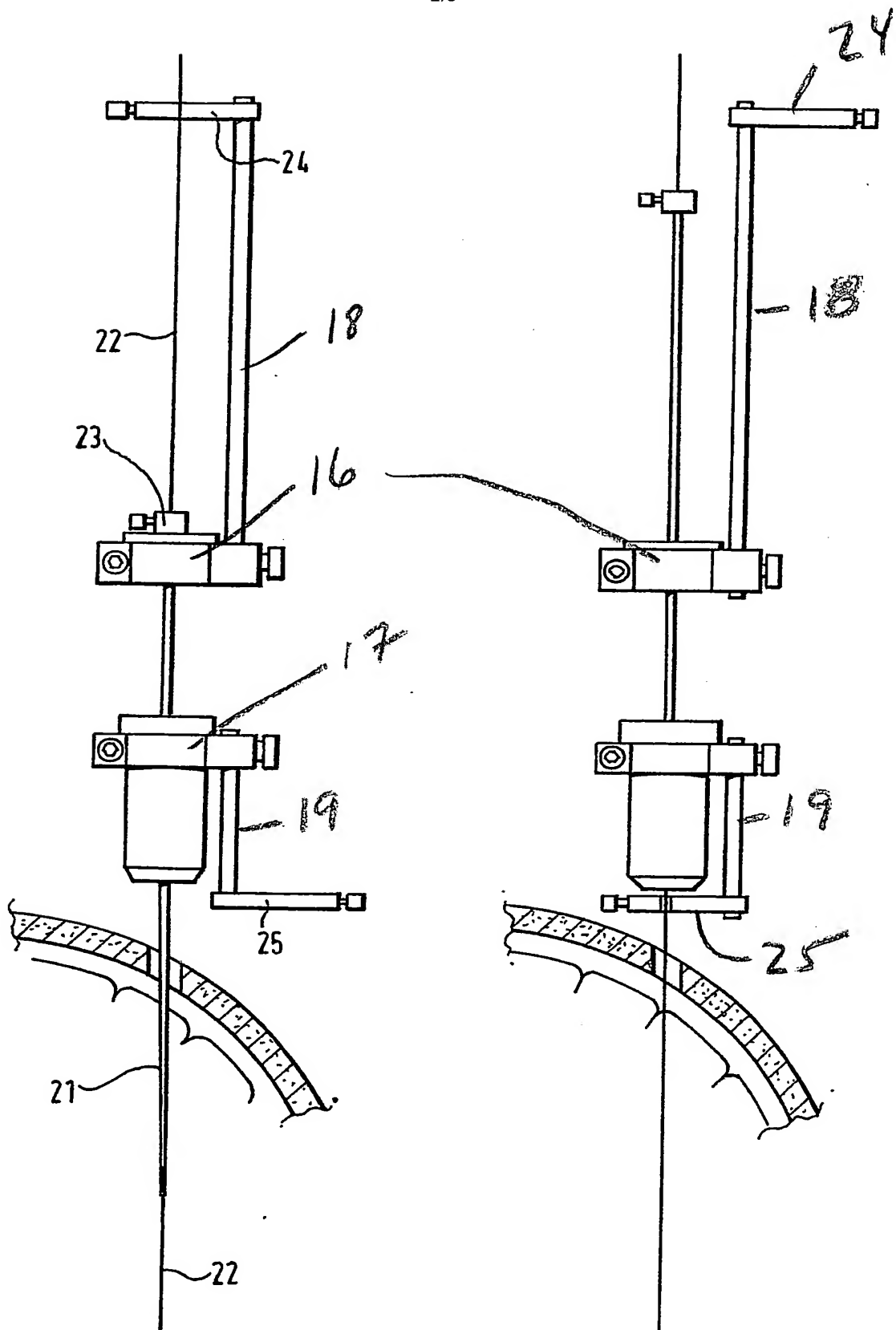


Fig.4.

Fig.5.

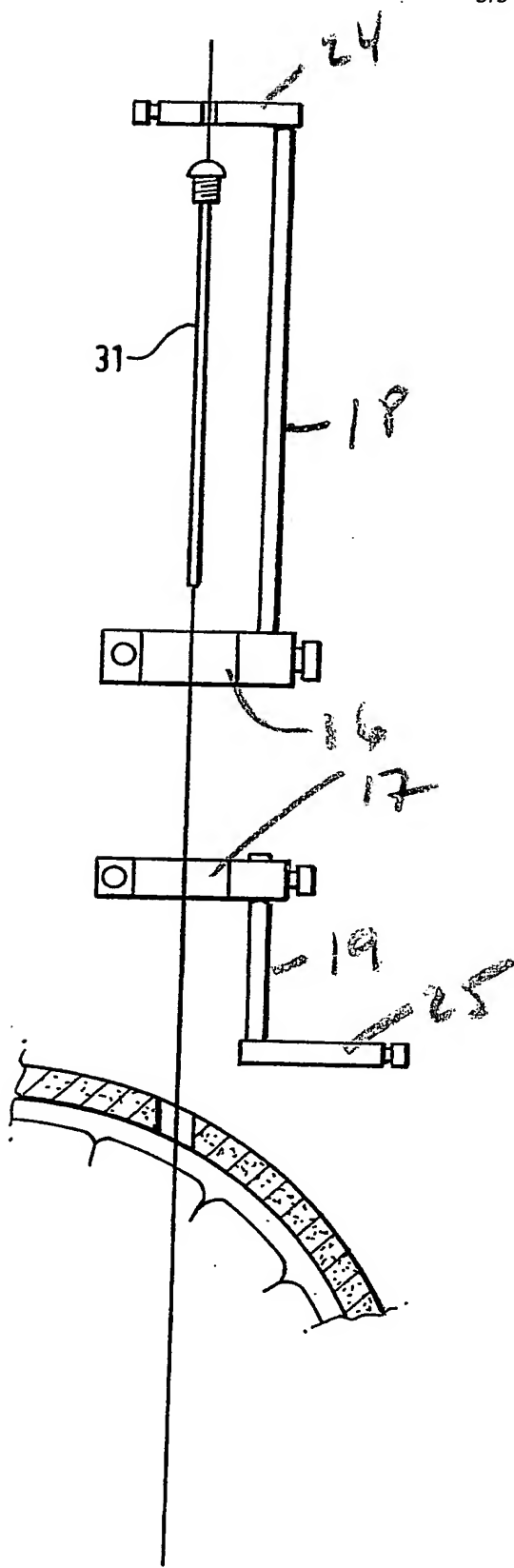


Fig. 6.

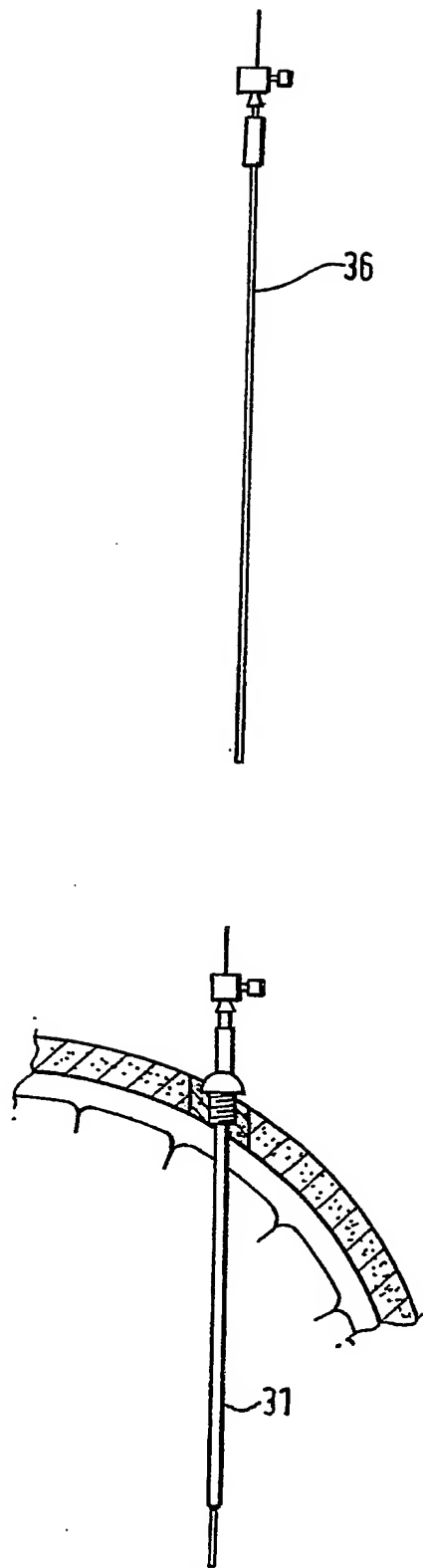


Fig. 7.